

Serial No.: 10/016,161

RD26440-5

Amtd. Dated January 16, 2004

Reply to Office action of December 16, 2003.

### REMARKS

In the Office Action of September 9, 2003, claims 25 – 35 were rejected. In this response, claims 25 and 36 have been amended. Claims 25 – 36 remain pending in the application. In accordance with 37 CFR 1.121 (f) no new matter has been added. In a response dated December 4, 2003, the Applicants responded to each of the issues raised in the Office Action of September 9, 2003. The Applicants thereafter on December 16, 2003 were sent notification that their amendment filed on December 4, 2003 was considered “not fully responsive” because the disposition of claims 1-24 was not made explicit. In this communication, the Applicants again respond to each of the issues raised in the Office Action of September 9, 2003, and show claims 1-24 as having been cancelled in the listing of the claims on page 2 of this paper. The Applicants point out that claims 1-24 were cancelled in the Division Application Transmittal Form submitted 12/10/01.

#### 35 U.S.C. § 112 Rejections

The Examiner has rejected claims 25 – 35 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention. The Examiner pointed out that claim 25 lacked “express antecedent basis” for the phrase “carbonate and ester units”. In response, the Applicant has amended claim 25 to recite the term “oxycarbonyl group” instead of “carbonate and ester units”. Those skilled in the art will appreciate that the term “oxycarbonyl group” embraces both “carbonate” and “ester” units.

Although the Examiner allowed originally filed claim 36, the Applicant has amended claim 36 to recite “to afford a copolymer comprising carbonate units” in order to provide antecedent basis for the final phrase of the claim, “thus hydrolyzing carbonate units”. The Application on page 10 lines 1-12, page 11 lines 5-12 and elsewhere provides ample antecedent basis for adapting claim 36 to recite the phrase “to afford a copolymer comprising carbonate units”.

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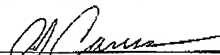
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Especially as amended, claims 25 – 36 are definite and distinctly claim the subject matter of the invention. Therefore, the Applicant respectfully requests that the rejection of claims 25 – 35 under 35 U.S.C. § 112, second paragraph, be withdrawn.

In view of the foregoing amendments and arguments, the Applicant believes that each of claims 25 – 36 is now in condition for allowance. The Applicant thus courteously solicits a review of the proposed amendments and prompt allowance of these claims. Should the Examiner believe that anything further is needed to place the application in even better condition for allowance, the Examiner is requested to contact the Applicant's undersigned representative at the telephone number below.

Respectfully submitted,

  
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Andrew J. Caruso  
Reg. No. 48,520

General Electric Company  
Building K1, Room 3A71  
Schenectady, New York 12301  
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Telephone: (518) 387-7354